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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,509	02/28/2002	Louis J. Panaccione	PURP01/0010	2163
826	7590	04/25/2007	EXAMINER	
ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000			PATTERSON, MARIE D	
			ART UNIT	PAPER NUMBER
			3728	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/25/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/086,509

Applicant(s)

PANACCIONE, LOUIS J.

Examiner

Marie Patterson

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 2, 4-6, 8-10, 12, 13, 15, and 19-22 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Erickson (6408543).

Erickson shows an insole comprising a plurality of heel pieces (24, 60, 62, and 64), a plurality of forefoot piece (22, see column 7 line 38-column 8, line 17), interlocking and retaining means (26, 42, 58, 25b, and 59), and a forefoot cushioning means (27) as claimed.

3. Claims 1, 2, 4-6, 8-10, and 19-22 are rejected under 35 U.S.C. 102(b) as being anticipated by MacNamara (6092311).

MacNamara shows an insole comprising a heel piece (20) with first interlocking means (64, see column 4 lines 20-25), forefoot pieces (30, 40, and 50) some with a forefoot centering periphery (shown in figures 1A and 1B), and second interlocking means (62) as claimed.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 5, 6, 8, and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Torchia (1733678) in view of Erickson.

Torchia shows an insole comprising a heel piece (1 and 2) with a first interlocking means (6), a forefoot piece (11) with a second interlocking means (12), means for retaining the pieces together (frictional engagement), and a heel cup (formed by element 15 and 14) substantially as claimed except for providing a plurality of the forefoot pieces. Erickson teaches providing a plurality of forefoot pieces (22, see column 7 line 38-column 8, line 17). It would have been obvious to provide a plurality of forefoot pieces as taught by Erickson in the insole of Torchia to increase the adjustability and customization of the insole.

6. Claims 3, 7, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erickson or Torchia as modified above.

Erickson or Torchia as modified above shows an insole substantially as claimed except for the exact means for retaining the interlocking means together and the exact material hardnesses. The use of adhesive to retain elements together is well known and conventional and also low tack adhesives are a well known alternative to hook and loop fasteners. It has been held to be within the general skill of a worker in the art to

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select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. It would have been obvious to provide adhesive and to use materials with hardnesses as claimed in the insole of either Erickson or Torchia as modified above to prevent the elements from sliding apart and to provide appropriate support and durability materials.

7. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over either Erickson or Torchia as modified above in view of Dahle (5230170).

Erickson or Torchia as modified above shows an insole substantially as claimed except for a chemically reactive forefoot pad. Dahle teaches providing a chemically reactive forefoot pad (42) in an insole. It would have been obvious to provide a chemically reactive forefoot pad as taught by Dahle in the insole of either Erickson or Torchia as modified above to provide warmth to the foot in cold weather.

Drawings

8. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 9/12/02 have been approved by the Examiner. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

Response to Arguments

9. Applicant's arguments filed 12/22/06 have been fully considered but they are not persuasive.

In response to applicants' arguments directed towards Erickson, Erickson clearly states and teaches the use of a plurality of forefoot members, see column 7 line 38-column 8, line 17.

In response to applicants' arguments directed towards MacNamara, the heel piece 20 is considered to be a heel piece of an insole inasmuch as applicant has claimed such. It is noted that the claims are directed towards as "cushioned insole support system...comprising....a plurality of left-foot heel pieces" and element 20 is clearly a heel piece of a support system.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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1. Telephone inquiries regarding the status of application or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the Examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148 or the **Tech Center 3700 Customer Service Center number is (703) 306-5648**. For applicant's convenience, the Group Technological Center FAX number is (703) 872-9302. (Note that the Examiner **cannot** confirm receipt of faxes) Please identify Examiner ____ of Art Unit ____ at the top of your cover sheet of any correspondence submitted.

Inquiries only concerning the **merits** of the examination should be directed to Marie Patterson whose telephone number is (703) 308-0069.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g. copies of references cited, form PTO-1449, for PTO-892, etc. requests for copies of such papers should be directed to (703) 308-1337.

Check out our web-site at "www.uspto.gov" for fees and other useful information.



Marie Patterson
Primary Examiner
Art Unit 3728